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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,808	09/03/2003	Michel Andre Bachmann	80350-1120	4511

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

MENDOZA, MICHAEL G

ART UNIT PAPER NUMBER

3731

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/653,808

Applicant(s)

BACHMANN, MICHEL ANDRE

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/24/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claim 1, lines 3, 4, and 5, and in claim 18, line 4, it is unclear and vague as to what "its" is directed to.
4. Claim 1 recites the limitation "the body" in line 8. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 8-11, and 16-18 are rejected under 35 U.S.C. 102(b) as being Forsoell by WO 01/49245.
7. Forsoell teaches a surgical ring designed to be implanted in the body of a patient around biological organs having a pouch or a duct in order to form a closed loop between its two extremities, thus forming a first and second extremities and reduce the diameter of the opening of the organ when it is tightened by the ring, the ring comprising

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a system for reversibly controlling the variation in its diameter, the systems comprising a flexible filiform element 52, wherein the flexible filiform element is inserted longitudinally with possibility of sliding into the material constituting the body of the ring (figs. 7, 9, 10), substantially between the first and second extremities so as to define a fixed portion united with the first extremity and a free portion which is functionally associated with an actuator mounted on the ring near the second extremity such that the actuator ensures reversible translation of the flexible filiform element in order to obtain a variation associated with the diameter of the ring (figs. 7, 9, 10); and the free portion is provided with a means of force cooperation with the actuator 50, the means of force cooperation being formed of a screw thread pitch 50; the flexible filiform element is formed of a flexible core 52 on which at least one spring 50 with un-joined loops is affixed and coaxially wound, making the screw thread pitch 50; the actuator is an electric motor 22; the electric motor 22 is linked to a receiving antenna 334 designed to be implanted in the body of the patient (pg. 40, lines 9-14); an emitting antenna 332 arranged outside the patient, in order to send a control and power signal to the receiving antenna 334, the emitter antenna 332 being functionally linked to a control interface.

8. As to claims 16 and 17, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference

as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

9. Claims 1, 2, 8, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Reimels 4118805.

10. Reimels teaches a surgical ring designed to be implanted in the body of a patient around biological organs having a pouch or a duct in order to form a closed loop between its two extremities, thus forming a first and second extremities and reduce the diameter of the opening of the organ when it is tightened by the ring, the ring comprising a system for reversibly controlling the variation in its diameter, the systems comprising a flexible filiform element 19, wherein the flexible filiform element is inserted longitudinally with possibility of sliding into the material constituting the body of the ring (fig. 3), substantially between the first and second extremities so as to define a fixed portion united with the first extremity and a free portion which is functionally associated with an actuator mounted on the ring near the second extremity such that the actuator ensures reversible translation of the flexible filiform element in order to obtain a variation associated with the diameter of the ring (col. 3, line 52-col. 4, line 32, fig. 3); and the free portion is provided with a mean of force cooperation with the actuator 28, the means of force cooperation being formed of a screw thread pitch 16; the flexible filiform element 19 is formed of a flexible core on which at least one spring with un-joined loops is affixed and coaxially wound, making the screw thread pitch 16; and the actuator is an electric motor (col. 2, lines 21-26).

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11. As to claims 16 and 17, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Allowable Subject Matter

12. Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dawson can be reached on (571) 272-4694. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MM


GLENN K. DAWSON
PRIMARY EXAMINER